

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MASSACHUSETTS

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BIS Advanced Software Systems, Ltd.,

Plaintiff,

v.

Red Bend Software, Inc., *et al*,

Defendants.

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Civil Action No. 04-11960-RWZ

**MOTION TO DISMISS WITH PREJUDICE**

Plaintiff BIS Advanced Software Systems, Ltd., through counsel, hereby requests dismissal of its claims, with prejudice, with each party to bear its own costs and attorneys' fees. FED. R. CIV. P. 41(a)(2).

Plaintiff further requests dismissal of all the declaratory judgment counterclaims raised by Defendants in this action, *i.e.* for non-infringement and invalidity, without prejudice, with each party to bear its own costs and attorneys' fees. To that end, Plaintiff hereby agrees not to sue any Defendant named in this action for infringement of any claim of U.S. Patent No. 6,401,239 based upon the software products and services currently manufactured, sold, and licensed by Defendant Red Bend in the United States. The Federal Circuit has found that such an agreement not to sue mooted the controversy and divested a District Court of jurisdiction over an accused infringer's declaratory judgment counterclaims of non-infringement and invalidity. *Super Sack Mfg. Corp. v. Chase Pkg., Corp.*, 57 F.3d 1054, 1056 (Fed. Cir. 1995); *see also*, *Intellectual Prop. Dev., Inc. v. TCI Cablevision of Calif., Inc.*, 248 F.3d 1333, 1342 (Fed. Cir. 2001).

For the reasons stated above, Plaintiff respectfully requests that this Court dismiss Plaintiff's claims with prejudice and Defendants' counterclaims without prejudice, with each party to bear its own costs and attorneys' fees.

Respectfully submitted,

BIS ADVANCED SOFTWARE SYSTEMS, LTD.

By its attorneys,

/s/ Scott McConchie

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Dated: December 1, 2005

Certificate under Local Rule 7.1

In accordance with Local Rule 7.1(a)(2), Caitlin Lhommedieu, counsel for Plaintiff, certifies that on December 1, 2005, she conferred with counsel for Defendants, Anastasia Fernands, about this motion and attempted in good faith to resolve the matter, but was unable to reach agreement.

/s/ Caitlin Lhommedieu

Caitlin Lhommedieu